

## REMARKS

This paper is responsive to an Office Action mailed August 20, 2007. Prior to this response, claims 1-42 were pending. After amending claims 1-2, 4-6, 9-13, 15-22, 29-31, 36-37, and 41-42, claims 1-42 remain pending.

In Section 1 of the Office Action objections are made to the Abstract. In response, the Abstract has been amended to replace the word “comprises” with the term “including the steps of”.

In Section 2 of the Office Action objections are made to claims 1-19, 21-37, and 41-42. In response, the claims have been amended as suggested in the Office Action.

In Section 4 of the Office Action claims 1-2, 9-10, 12-13, and 17-22, 32, 36-38, and 41-42 have been rejected under 35 U.S.C 102(a) as anticipated by Ferlitsch (US 6,943,905). With respect to claims 1 and 20, the Office Action states that Ferlitsch discloses all the limitations of the claimed invention. This rejection is traversed as follows.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Generally, Ferlitsch discloses a client device and an associated virtual printer driver. The virtual printer driver surveys all the printers in the system, and based upon the printer capabilities, makes a “best fit” selection of a printer (column 4, lines 34-60). More explicitly, the client computing device generates a print job and calls a virtual

printer driver. The virtual printer driver gathers information on the capabilities, locality, and status of one or more output devices (column 8, lines 47-62). It should be noted that this analysis is carried out before a print job is sent to a printer. The virtual printer driver directs the print job automatically selecting the best fit between the capabilities of the output devices and the options and requirements of the print job (column 9, lines 5-11).

In contrast, claims 1 and 20 (as amended) recite an imaging device which receives an imaging job. Once the job is received at the imaging device, an analysis is performed comparing the characteristics of the imaging job to the capabilities of the imaging device. That is, Ferlitsch's process makes an analysis of the print job and the capabilities of a printer at a client prior to sending the print job to an imaging device. The Applicant's claims recite performing analysis of imaging job and device capabilities at the imaging device after the receipt of the print job.

Therefore, with respect to claims 1 and 20, Ferlitsch does not disclose the limitation of determining image job characteristics or imaging system capabilities after the receipt of an imaging job at an imaging device. Because Ferlitsch does not explicitly disclose all these limitations, he cannot anticipate claims 1 and 20. Claims 2, 9-10, 12-13, and 17-19, dependent from claim 1, and claims 21-22, 32, 36-38, and 41-42, enjoy the same this actions from the cited prior art reference, and the Applicant respectfully requests that the rejection be removed.

In Section 6 of the Office Action, claims 3-7, 23, 26-27, and 29-34 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Ferlitsch in view of Wadley (US 2002/0181014). The Office

Action acknowledges that Ferlitsch fails to disclose determining available print media and available links. The Office Action states that Wadley discloses these features, and it would have been obvious to include the features of Wadley into Ferlitsch's process as a way for an organization to monitor the content of documents being printed on organization printer resources. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Wadley discloses a system where monitoring software installed on a printer is used to determine whether the data streams associated with documents are of interest to the organization [0009]. As an example, ink and the print media can be determined.

The obviousness rejection appears to be based upon the assumption that Ferlitsch discloses all the limitations of claims 1 and 20. However, as noted above, Ferlitsch does not disclose the limitations of determining image job characteristics or imaging system capabilities

after the receipt of an imaging job at an imaging device. With respect to the third *prima facie* requirement, even if it would have been obvious incorporate Wadley's ink and print media management into Ferlitsch's process, that combination still fails to describe an imaging device that analyzes imaging device capabilities and imaging job characteristics upon the receipt of an imaging job. That is, the combination of Ferlitsch and Wadley fails to teach every limitation of claims 1 and 20. Claims 3-7, dependent from claim 1, and claims 23, 26-27, and 29-34, dependent from claim 20, enjoy the same distinctions.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to include the features of Wadley into Ferlitsch's process as a way for an organization to monitor the content of documents being printed on organization printer resources. However, this argument does not explain how a practitioner could use Wadley as a reference to modify Ferlitsch's system until it included all the limitations of claims 1 and 20.

As noted in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), *amended*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a

*prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

A *prima facie* analysis is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in either the prior art reference. As noted in addressing the third *prima facie* requirement, neither reference discloses the limitations of determining image job characteristics or imaging system capabilities after the receipt of an imaging job at an imaging device. Therefore, the claimed invention can only be obvious if an artisan makes substantial modifications to the Ferlitsch reference. In this case, it is not relevant that there is some kind of motivation to combine Wadley with Ferlitsch. There are multitudes of references that may be combined for many reasons. However, for the first *prima facie* analysis, the only references that are relevant are ones who teach the claimed invention when combined.

In other words, no evidence has been provided to show that an artisan, seeking to monitor an organization, would be motivated to modify Ferlitsch's client-side process into a process that analyzes a print job at an imaging device after receipt of a job. While Ferlitsch's process may be useful to someone working at a PC prior to sending a print job, the Applicant's process is more useful for a person already standing at the imaging device, using the front panel for example.

Alternately, the *prima facie* case of obviousness based upon the modification of Ferlitsch could potentially be supported using the knowledge of a person with skill in the art, to supply the motivation lacking in the Ferlitsch reference itself. "(A)nalysis [of whether the

subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. When the limitations are not supplied in the prior art reference, it would especially critical to supply evidence of the kind of knowledge that an artisan is assumed to have. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action has not supplied any explanation of the analysis an artisan might employ to modify Ferlitsch’s client-side mechanism in a manner that yields all the explicit limitations recited in the base claims.

Considered from the perspective of the second *prima facie* requirement, even if a practitioner were given the Ferlitsch and Wadley references, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. Alternately stated, there can be no expectation of success if the prior does not teach or suggest all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of references does not explicitly disclose every limitation of claims 1 and 20.

Neither has a case been supported that Ferlitsch can be modified to supply the missing limitations in view of Wadley. Finally, a case has not been supported that Ferlitsch can be modified to supply the missing limitations in view of what was known by a person of skill at the time of the invention. Since a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claims 3-7, 23, 26-27, and 29-34 be removed.

In Section 7 of the Office Action, claims 8 and 25 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Ferlitsch and Wadley, in view of Neuhard et al. ("Neuhard"; US 6,052,198). The Office Action acknowledges that Ferlitsch and Wadley fail to disclose determining available print media information and determining available print media for subsequent jobs. The Office Action states that Neuhard discloses these features, and it would have been obvious to include the features of Neuhard into Ferlitsch and Wadley to make a more efficient system. This rejection is traversed as follows.

The obviousness rejection assumes that Ferlitsch discloses all the limitations of claims 1 and 20. However, as noted above, Ferlitsch does not disclose the limitations of determining image job characteristics or imaging system capabilities after the receipt of an imaging job at an imaging device. With respect to the third *prima facie* requirement, even if it would have been obvious incorporate Neuhard's features into the Ferlitsch/Wadley process, that combination still fails to describe an imaging device that analyzes imaging device capabilities and imaging job characteristics upon the receipt of an imaging job, as recited

in claims 1 and 20. Claim 8, dependent from claim 1, and claim 25, dependent from claim 20, enjoy the same distinctions.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to include the features of Wadley into the Ferlitsch/Wadley process to improve efficiency. However, a *prima facie* analysis must cite references whose combination teaches all the elements of the claimed invention.

Considered from the perspective of the second *prima facie* requirement, even if a practitioner were given the Ferlitsch, Wadley, and Neuhard references, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of references does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that Ferlitsch can be modified to supply the missing limitations in view of Neuhard. Finally, a case has not been supported that Ferlitsch can be modified to supply the missing limitations in view of what was known by a person of skill at the time of the invention. Since a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claims 8 and 25 be removed.

In Section 8 of the Office Action, claims 14-15 and 39-40 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Ferlitsch, in view of Wiechers (US 2002/0075509). The Office Action acknowledges that Ferlitsch fails to disclose establishing mismatch criteria and supplying a warning. The Office Action states that Wiechers



discloses these features, and it would have been obvious to include the features of Wiechers into Ferlitsch to satisfy cost and time parameters. This rejection is traversed as follows.

As above, the obviousness rejection assumes that Ferlitsch discloses all the limitations of claims 1 and 20. However, Ferlitsch does not disclose the limitations of determining imaging job characteristics or imaging system capabilities after the receipt of an imaging job at an imaging device. With respect to the third *prima facie* requirement, even if it would have been obvious incorporate Wiechers' features into the Ferlitsch process, that combination still fails to describe an imaging device that analyzes imaging device capabilities and imaging job characteristics upon the receipt of an imaging job, as recited in claims 1 and 20. Claims 14-15, dependent from claim 1, and claims 39-40, dependent from claim 20, enjoy the same distinctions.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to include the features of Wiechers into the Ferlitsch process to satisfy cost and time parameters. However, an analysis of the motivation to combine references only becomes relevant if the combination of references teaches all the limitations of the claimed invention.

Considered from the perspective of the second *prima facie* requirement, even if a practitioner were given the Ferlitsch and Wiechers references, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of references does not explicitly disclose every limitation of claims 1 and 20.

Neither has a case been supported that Ferlitsch can be modified to supply the missing limitations in view of Wiechers. Finally, a case has not been supported that Ferlitsch can be modified to supply the missing limitations in view of what was known by a person of skill at the time of the invention. Since a *prima facie* case of obviousness has not been supported, and the Applicant requests that the rejection of claims 14-15 and 39-40 be removed.

In Section 9 of the Office Action, claim 24 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Ferlitsch, in view of Walker et al. ("Walker"; US 6,561,643). The Office Action acknowledges that Ferlitsch fails to disclose a reader interface. The Office Action states that Walker discloses this feature, and it would have been obvious to include the features of Walker into Ferlitsch to automatically adjust the printing of optical images.

As above, the obviousness rejection assumes that Ferlitsch discloses all the limitations of claim 20. However, Ferlitsch does not disclose the limitations of determining imaging job characteristics or imaging system capabilities after the receipt of an imaging job at an imaging device. With respect to the third *prima facie* requirement, even if it would have been obvious to incorporate Walker's features into the Ferlitsch process, that combination still fails to describe an imaging device that analyzes imaging device capabilities and imaging job characteristics upon the receipt of an imaging job, as recited in claim 20. Claim 24, dependent from claim 20, enjoys the same distinctions.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to include the features of

Walker into the Ferlitsch process to automatically adjust printing. However, an analysis of the motivation to combine references only becomes relevant if the combination of references teaches all the limitations of the claimed invention.

Considered from the perspective of the second *prima facie* requirement, even if a practitioner were given the Ferlitsch and Walker references, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of references does not explicitly disclose every limitation of claim 20. Neither has a case been supported that Ferlitsch can be modified to supply the missing limitations in view of Walker. Finally, a case has not been supported that Ferlitsch can be modified to supply the missing limitations in view of what was known by a person of skill at the time of the invention. Since a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claim 24 be removed.

In Section 10 of the Office Action, claim 28 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Ferlitsch, in view of Wadley, and further in view of Hayward et al. ("Hayward"; US 7,031,004). The Office Action acknowledges that Ferlitsch fails to disclose a web page interface. The Office Action states that Hayward discloses this feature, and it would have been obvious to include the features of Hayward into Ferlitsch/Wadley to send a print job with robust and top level options.

The obviousness rejection assumes that Ferlitsch discloses all the limitations of claim 20. However, Ferlitsch does not disclose the limitations of determining image job characteristics or imaging system capabilities after the receipt of an imaging job at an imaging device. With respect to the third *prima facie* requirement, even if it would have been obvious incorporate Hayward's features into the Ferlitsch/Wadley process, that combination still fails to describe an imaging device that analyzes imaging device capabilities and imaging job characteristics upon the receipt of an imaging job, as recited in claim 20. Claim 28, dependent from claim 20, enjoys the same distinctions.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to include the features of Hayward into the Ferlitsch/Wadley process to provide a print job with robust and top level options. However, an analysis of the motivation to combine references only becomes relevant if the combination of references teaches all the limitations of the claimed invention.

Considered from the perspective of the second *prima facie* requirement, even if a practitioner were given the Ferlitsch, Wadley, and Hayward references, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of references does not explicitly disclose every limitation of claim 20. Neither has a case been supported that Ferlitsch can be modified to supply the missing limitations in view of Hayward. Finally, a case has not been supported that Ferlitsch can be modified to supply the missing limitations in view of what was known by a person of skill at the time of

the invention. Since a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claim 28 be removed.

In Section 11 of the Office Action, claim 35 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Ferlitsch, in view of Hayward. The Office Action acknowledges that Ferlitsch fails to disclose a web page interface. The Office Action states that Hayward discloses this feature, and it would have been obvious to include the features of Hayward into Ferlitsch to send a print job with robust and top level options.

The obviousness rejection assumes that Ferlitsch discloses all the limitations of claim 20. However, Ferlitsch does not disclose the limitations of determining image job characteristics or imaging system capabilities after the receipt of an imaging job at an imaging device. With respect to the third *prima facie* requirement, even if it would have been obvious incorporate Hayward's features into the Ferlitsch process, that combination still fails to describe an imaging device that analyzes imaging device capabilities and imaging job characteristics upon the receipt of an imaging job, as recited in claim 20. Claim 35, dependent from claim 20, enjoys the same distinctions.

With respect to the first *prima facie* requirement, the Office Action states that it would have been obvious to include the features of Hayward into the Ferlitsch process to provide a print job with robust and top level options. However, an analysis of the motivation to combine references only becomes relevant if the combination of references teaches all the limitations of the claimed invention.

Considered from the perspective of the second *prima facie* requirement, even if a practitioner were given the Ferlitsch and Hayward references, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of references does not explicitly disclose every limitation of claim 20. Neither has a case been supported that Ferlitsch can be modified to supply the missing limitations in view of Hayward. Finally, a case has not been supported that Ferlitsch can be modified to supply the missing limitations in view of what was known by a person of skill at the time of the invention. Since a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claim 35 be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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Gerald Maliszewski  
Registration No. 38,054

Customer Number 55,286  
P.O. Box 270829  
San Diego, CA 92198-2829  
Telephone: (858) 451-9950  
Facsimile: (858) 451-9869  
gerry@ipatentit.net